

ESTTA Tracking number: **ESTTA444489**

Filing date: **12/05/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Pirelli Tyre, S.p.A.
Granted to Date of previous extension	12/21/2011
Address	Viale Sarca 222 Milano, I-20136 ITALY

Attorney information	Laurence R. Hefter Finnegan Henderson Farabow Garrett & Dunner, LLP 901 New York Avenue, NW Washington, DC 20001-4413 UNITED STATES docketing@finnegan.com, larry.hefter@finnegan.com, virginia.carron@finnegan.com, judy.valusek@finnegan.com Phone:202-408-4000
----------------------	--

### Applicant Information

Application No	85282324	Publication date	08/23/2011
Opposition Filing Date	12/05/2011	Opposition Period Ends	12/21/2011
Applicant	STAFFORD, RONAN 26 OULTON ROAD CLONTARD, DUBLIN, 3 IRELAND		

### Goods/Services Affected by Opposition

Class 012. All goods and services in the class are opposed, namely: Bicycle parts and accessories, namely, chain rings, crank sets, bottom brackets, headsets, hubs, stems, seatposts, handlebars, handlebar grips and chain ring bolts and excluding tires, all for use on mountain bikes, and all not for use on motorized cycles or motorcycles
---

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1467219	Application Date	03/02/1987
-----------------------	---------	------------------	------------

Registration Date	12/01/1987	Foreign Priority Date	10/06/1986
Word Mark	DEMON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: TIRES AND INNER TUBES		

Attachments	12-5-11 Notice of Opposition - DEMON.pdf ( 15 pages )(398063 bytes )
-------------	--

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Laurence R. Hefter/
Name	Laurence R. Hefter
Date	12/05/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>PIRELLI TYRE S.P.A.</p> <p>Opposer</p> <p>v.</p> <p>RONAN STAFFORD,</p> <p>Applicant.</p>	<p>Opposition No.</p> <p>Serial No. 85282324</p> <p>Mark: DEMON</p> <p>Filing Date: March 31, 2011</p>
--	--

**NOTICE OF OPPOSITION**

Pirelli Tyre S.p.A. ("Pirelli" or "Opposer"), a società per azioni of Italy, having a place of business at Viale Sarca 222, I-20136 Milan, Italy, believes that it is being and will be damaged by the registration of the mark DEMON for bicycle parts and accessories, namely, chain rings, crank sets, bottom brackets, headsets, hubs, stems, seatposts, handlebars, handlebar grips and chain ring bolts and excluding tires, all for use on mountain bikes, and all not for use on motorized cycles or motorcycles in Application Serial No. 85282324, and hereby opposes the same. As grounds for opposition, Opposer alleges that, upon actual knowledge with respect to Opposer's own acts, and upon information and belief as to other matters:

**Opposer and its DEMON and DEMON-formative Marks**

1. Opposer, Pirelli Tyre S.p.A., is a società per azioni of Italy, having a place of business at Viale Sarca 222, I-20136 Milan, Italy.

2. Opposer, through its predecessors-in-interest, related companies, distributors and licensees (collectively “Opposer”), is one of the leading manufacturers and distributors of tires and tire products in the world. Pirelli’s tire products and related goods are sold throughout the world, including the United States, in connection with its DEMON mark and the marks SPORT DEMON and CITY DEMON (“DEMON-formative marks”). Further, the Pirelli DEMON and DEMON-formative marks have been used in commerce in connection with the advertising, promotion and sale of Pirelli’s tires and related products in the United States since prior to the filing date of the opposed application and any date of first use that may be alleged by Applicant.

3. Pirelli is the owner of United States trademark Registration No. 1467219 for the mark DEMON for “tires and inner tubes” in International Class 12. (Printouts from the PTO TESS/TARR and assignment databases are attached as Exhibit A.)

4. Pirelli’s United States Trademark Registration No. 1467219 is valid, subsisting and incontestable and constitutes *prima facie* evidence of the validity of the mark and registration, and of Pirelli’s ownership of and exclusive right to use the mark in commerce, and provides constructive notice of ownership thereof by Pirelli.

5. By virtue of its exclusive use, Pirelli is the owner of common law trademark rights in the trademarks DEMON, SPORT DEMON, and CITY DEMON for tires and related products.

6. As a result of Opposer’s promotional efforts and commercial success, its DEMON mark and its DEMON-formative marks have achieved widespread public recognition well prior to both the filing date of the subject application, and any date of first use that may be alleged by Applicant.

**Applicant and his DEMON Application**

7. Ronan Stafford ("Applicant") is an individual citizen of Ireland having an address of 26 Oulton Road, Clontard, Dublin, Ireland 3.

8. Applicant is the current owner of intent-to-use Application Serial No. 85282324, filed March 31, 2011, for the mark DEMON for "bicycle parts and accessories, namely, chain rings, crank sets, bottom brackets, headsets, hubs, stems, seatposts, handlebars, handlebar grips and chain ring bolts and excluding tires, all for use on mountain bikes, and all not for use on motorized cycles or motorcycles" in International Class 12.

**Likelihood of Confusion, 15 U.S.C. § 1052(d)**

9. Opposer repeats and realleges each and every allegation set forth in Paragraphs 1 through 8.

10. Opposer has priority based on its prior valid and subsisting registration for the mark DEMON set forth in Paragraphs 3 and 4 above. Further, since prior to the filing date of Application Serial No. 85282324, and any date of first use that may be alleged by Applicant, Opposer and its predecessors-in-interest and licensees have used, advertised, sold, and transported in commerce, *inter alia*, tires and inner tubes under the DEMON and DEMON-formative marks.

11. Applicant's DEMON mark is identical in sound, pronunciation, and appearance to Opposer's DEMON mark and is fully encompassed within Opposer's DEMON-formative marks. The products identified in the subject application are closely related to the products offered and sold by Opposer in connection with its DEMON mark

and DEMON-formative marks, and to the products covered by Opposer's valid and subsisting trademark registration.

12. In view of the similarity of the parties' marks and the closely related nature of the parties' goods, Applicant's mark DEMON so resembles Opposer's previously used and registered DEMON mark and its previously-used DEMON-formative marks, as to be likely to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d), 15 U.S.C. § 1052(d).

**Dilution, 15 U.S.C. § 1025(c)(1)**

13. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 12.

14. Opposer's DEMON and DEMON-formative marks became famous well before the filing dates of Applicant's application and any date of first use that may be alleged by Applicant.

15. Applicant's DEMON mark so closely resembles Opposer's previously registered DEMON mark and previously used DEMON and DEMON-formative marks as to be likely to cause dilution of the distinctive quality of Opposer's famous marks in violation of 15 U.S.C. § 1025(c)(1).

WHEREFORE, Opposer is being and will be damaged by the registration of Applicant's DEMON mark, and respectfully request that this opposition be sustained, and that the mark shown in Application Serial No. 85282324 be refused registration.

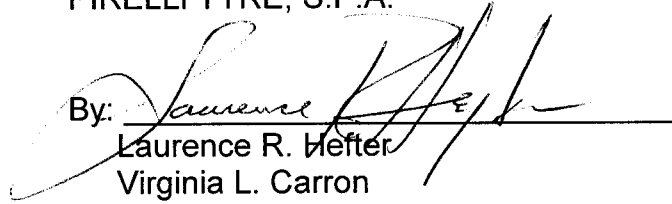
A filing fee has been submitted electronically. If the filing fee is found to be insufficient for any reason, please charge such deficiency to our Deposit Account No. 06-0916.

Respectfully submitted,

PIRELLI TYRE, S.P.A.

Dated: December 5, 2011

By:



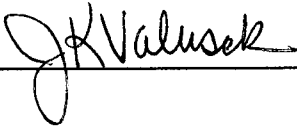
Laurence R. Hefter  
Virginia L. Carron  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER LLP  
901 New York Avenue, N.W.  
Washington, D.C. 20001-4413  
(202) 408-4000

Attorneys for Opposer

**CERTIFICATE OF SERVICE**

I certify that a true and accurate copy of the foregoing NOTICE OF  
OPPOSITION was served by first class mail, postage prepaid, on this 5<sup>th</sup> day of  
December 2011, upon counsel for Applicant at the following address of record:

Richard L. Morris, Jr., Esq.  
P. O. Box 398538  
Miami Beach, FL 33239-8538

  
\_\_\_\_\_



Notice of Opposition  
Pirelli Tyre S.p.A. v. Ronan Stafford  
Serial No. 85282324  
Mark: DEMON

# Exhibit A

**United States Patent and Trademark Office**[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)**Trademarks > Trademark Electronic Search System (TESS)***TESS was last updated on Mon Dec 5 04:35:46 EST 2011*[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [BOTTOM](#) [HELP](#)[Logout](#) Please logout when you are done to release system resources allocated for you.**Record 1 out of 1**[TARR Status](#) [ASSIGN Status](#) [TDR](#) [TTAB Status](#) ( Use the "Back" button of the Internet Browser to return to TESS)**Typed Drawing**

<b>Word Mark</b>	DEMON
<b>Goods and Services</b>	IC 012. US 035. G & S: TIRES AND INNER TUBES
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	73647054
<b>Filing Date</b>	March 2, 1987
<b>Current Filing Basis</b>	44E
<b>Original Filing Basis</b>	44D
<b>Published for Opposition</b>	September 8, 1987
<b>Registration Number</b>	<b>1467219</b>
<b>Registration Date</b>	December 1, 1987
<b>Owner</b>	(REGISTRANT) PIRELLI COORDINAMENTO PNEUMATICI S.P.A. CORPORATION ITALY PIAZZALE CADORNA, 5 20123 MILAN ITALY  (LAST LISTED OWNER) PIRELLI TYRE S.P.A. CORPORATION ITALY VIALE SARCA 222 MILANO ITALY I-20126
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Virginia L. Carron

<b>Priority Date</b>	October 6, 1986
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Affidavit Text</b>	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20070327.
<b>Renewal</b>	1ST RENEWAL 20070327
<b>Live/Dead Indicator</b>	LIVE

---

[TESS HOME](#)[NEW USER](#)[STRUCTURED](#)[FREE FORM](#)[BROWSE DICT](#)[SEARCH OG](#)[TOP](#)[HELP](#)

---

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2011-12-05 08:51:50 ET**

**Serial Number:** 73647054 Assignment Information Trademark Document  
Retrieval

**Registration Number:** 1467219

**Mark(words only):** DEMON

**Standard Character claim:** No

**Current Status:** The registration has been renewed.

**Date of Status:** 2007-03-27

**Filing Date:** 1987-03-02

**Transformed into a National Application:** No

**Registration Date:** 1987-12-01

**Register:** Principal

**Law Office Assigned:** (NOT AVAILABLE)

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location:** 830 -Post Registration

**Date In Location:** 2007-03-27

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

## 1. PIRELLI TYRE S.P.A.

**Address:**

PIRELLI TYRE S.P.A.

VIALE SARCA 222

MILANO I-20126

Italy

**Legal Entity Type:** Corporation**State or Country of Incorporation:** Italy

---

**GOODS AND/OR SERVICES**

---

**International Class:** 012**Class Status:** Active

TIRES AND INNER TUBES

**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

---

**ADDITIONAL INFORMATION**

---

**Foreign Application Number:** 22232C/86**Foreign Registration Number:** 474309**Foreign Registration Date:** 1987-03-27**Country:** Italy**Foreign Filing Date:** 1986-10-06**Foreign Expiration Date:** 2006-10-06

---

**MADRID PROTOCOL INFORMATION**

---

(NOT AVAILABLE)

---

**PROSECUTION HISTORY**

---

**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-03-27 - First renewal 10 year

2007-03-27 - Section 8 (10-year) accepted/ Section 9 granted

2007-03-23 - Assigned To Paralegal

2007-02-12 - Combined Section 8 (10-year)/Section 9 filed

2007-03-13 - Case File In TICRS

2007-02-14 - Automatic Update Of Assignment Of Ownership

2007-02-12 - TEAS Section 8 & 9 Received

1993-09-29 - Section 8 (6-year) accepted & Section 15 acknowledged

1993-06-11 - Section 8 (6-year) and Section 15 Filed

1987-12-01 - Registered - Principal Register

1987-09-08 - Published for opposition

1987-08-07 - Notice of publication

1987-07-09 - Approved for Pub - Principal Register (Initial exam)

1987-06-22 - Communication received from applicant

1987-05-29 - Non-final action mailed

1987-05-08 - Assigned To Examiner

---

#### **ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Virginia L. Carron

**Correspondent**

Virginia L. Carron

PIRELLI TYRE S.P.A.

901 New York Avenue NW

WASHINGTON, DC 20001-4413

**Domestic Representative**  
BRUCE E. LILLING

---



## United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz](#)  
[alerts](#) | [News](#) | [Help](#)

Assignments on the Web > Trademark Query

## Trademark Assignment Abstract of Title

## Total Assignments: 2

Serial #: 73647054

Filing Dt: 03/02/1987

Reg #: 1467219

Reg. Dt: 12/01/1987

Registrant: PIRELLI COORDINAMENTO PNEUMATICI S.P.A.

Mark: DEMON

## Assignment: 1

Reel/Frame: 1923/0317

Received: 07/06/1999

Recorded: 07/01/1999

Pages: 7

Conveyance: CHANGE OF NAME

Assignor: PIRELLI COORDINAMENTO PNEUMATICI, S.P.A.

Exec Dt: 05/11/1999

Entity Type: CORPORATION

Citizenship: ITALY

Entity Type: CORPORATION

Citizenship: ITALY

Assignee: PIRELLI PNEUMATICI S.P.A.

FVIALE SARCA 222

20126 MILAN, ITALY

Correspondent: FINNEGAN, HENDERSON, FARABOW, ET AL.

VIRGINIA L. CARRON

1300 I STREET, NW

WASHINGTON, DC 20005-3315

Domestic rep: FINNEGAN, HENDERSON, FARABOW, ET AL.

1300 I STREET, NW

WASHINGTON, DC 20005-3315

## Assignment: 2

Reel/Frame: 3479/0054

Received: 02/09/2007

Recorded: 02/09/2007

Pages: 3

Conveyance: CHANGE OF NAME

Assignor: PIRELLI PNEUMATICI S.P.A.

Exec Dt: 06/14/2006

Entity Type: CORPORATION

Citizenship: ITALY

Entity Type: CORPORATION

Citizenship: ITALY

Assignee: PIRELLI TYRE S.P.A.

VIALE SARCA 222

MILANO, ITALY I-20126

Correspondent: VIRGINIA L. CARRON

901 NEW YORK AVENUE NW

WASHINGTON, DC 20001-4413

Domestic rep: VIRGINIA L. CARRON

901 NEW YORK AVENUE NW

WASHINGTON, DC 20001-4413

Search Results as of: 12/05/2011 08:51 AM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.2

Web interface last modified: July 25, 2011 v.2.2

[| .HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)



